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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Lewis R. Dove, et al.

Serial No.: 10/783,465

Examiner: Benny T. Lee

Filing Date: February 20, 2004

Group Art Unit: 2817

Title: METHODS AND APPARATUS FOR COUPLING FIRST AND SECOND MICROWAVE MODULES

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on July 11, 2006. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 50-1078.

Respectfully submitted,

Lewis R. Dove, et al.

- ☒ I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.

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Date: September 11, 2006

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No. : 10/783,465 Confirmation No. 7444
Appellant : Lewis R. Dove et al.
Filed : February 20, 2004
TC/A.U. : 2817
Examiner : Benny T. Lee

Docket No. : 10020706-1

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

This Reply Brief is submitted in response to the Examiner's Answer of July 11, 2006.

In the Examiner's Answer of July 11, 2006, and on pages 7-8, the Examiner indicates:

In considering appellant' arguments regarding claims 1, 9, 10, 16, and 22-25, the critical issue appears to be whether there is suggestion or motivation to combine certain features found in the individual reference and whether such a combination was made by the examiner relaying on impermissible hindsight. *The examiner acknowledges that Ishihara does not disclose ground shielding, which extends along the lateral edges of the microwave circuit to extend in a direction transverse to the conductor.* Accordingly, in view of such a deficiency in Ishihara, the examiner has provide the exemplary teachings of Arledge et al reference, which recognizes the critical benefits of a fully shielded microwave circuit in terms of reduced signal leakage. ...while Arledge et al does not provide suggestion or motivation for those features alluded to by appellants', *such features are accounted for in Ishihara...*it would have been obvious to have added transverse oriented ground planes to the lateral edges of the microwave circuits of Ishihara to have provided the advantageous benefit of reducing leakage from otherwise unshielded lateral edges. ...when the combination of references are taken together, rather than individually, *these references do indeed provided a suggestion or motivation to make the proposed combination set forth in the above rejection.* See MPEP2145(IV). Namely, there is an advantageous benefit in improved shielding afforded by the exemplary teaching in Arledge et al to be gained

when applied to the analogous art structure in Ishihara, thus producing the suggestion or motivation to have made such a combination. Moreover, since the suggestion or motivation for making the combination was found in the teachings and/or suggestions of the references themselves... Furthermore...even if the references taken as a whole, do not expressly provide any suggestion or motivation to make the combination, such a combination may none the less be considered proper, when the teaching and/or suggestions prior art references are taken in conjunction with ***common knowledge*** in the art (e.g. it is ***common knowledge in the art that shielding all exposes surface provides improved isolation and optimizes prevention of signal leakage***. See MPEP 2145(X)(A). (Italicized-bolded emphasis added.)

Appellants reassert the arguments made in the Appeal Brief, which was filed on June 5, 2006, and note that neither Ishihara nor Arledge provide any suggestion or motivation to one of ordinary skill in the art, without relying on improper hindsight, to provide the invention of Appellants' claims 1-25.

On page 8 of the Examiner's Answer of July 11, 2006, the Examiner cites MPEP 2145(IV). Appellants note that this section of the MPEP states:

IV. ARGUING AGAINST REFERENCES INDIVIDUALLY

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

However, Appellants are not merely attacking the two cited references individually. Appellants assert that the Examiner has not identified either an explicit or implicit suggestion or motivation in one or both of Ishihara and Arledge to modify the references. Appellants refer the Examiner to MPEP 2143.01 (III). This section of the MPEP states:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Appellants assert that the cited references, even together with the Examiner's statement above that it is "common knowledge in the art that shielding all exposes surface provides improved isolation and optimizes

prevention of signal leakage," clearly lacks any suggestion to combine the references in order to provide the invention of Appellants' claims 1-25.

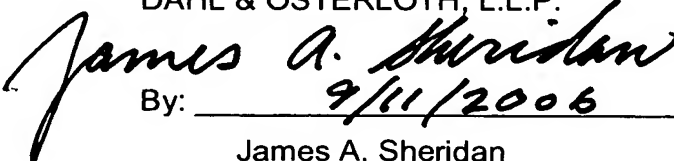
Furthermore, Appellants' respectfully disagree with the Examiner statement that "while Arledge et al does not provide suggestion or motivation for those features alluded to by appellants', such features are accounted for in Ishihara...it would have been obvious to have added transverse oriented ground planes to the lateral edges of the microwave circuits of Ishihara to have provided the advantageous benefit of reducing leakage from otherwise unshielded lateral edges." Appellants assert that the Examiner is relying on an improper hindsight analysis in that the Examiner has identified no such suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings as discussed above. For example, MPEP 2145(C) states:

As discussed in MPEP § 2143.01, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings. The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references, as discussed in the aforementioned section.

In summary, the art of record does not teach nor suggest the subject matter of Appellants' claims 1-25. These claims are therefore believed to be allowable.

Respectfully submitted,

DAHL & OSTERLOTH, L.L.P.


By: 9/11/2006

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